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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/661,739

09/14/2000

Jeffrey D. Ollis

D-2340

9031

7590

01/13/2005

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EXAMINER

THOMPSON, MARC D

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/661,739

Applicant(s)

OLLIS, JEFFREY D.

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 10 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/4/2004 has been entered.
2. Claims 1-13 remain pending.

Priority

3. This application claims priority to provisional application 60/156,248, filed 9/27/1999.
4. The effective filing date for the subject matter defined in the pending claims in this application which have support in the provisional application is 9/27/1999.

Drawings

5. The Examiner contends that the drawings submitted on 12/22/2002 are acceptable for examination proceedings.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-8, and 13 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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8. Claim 1 recites “system user characteristics” (Lines 4-5) and later references “the user” (Line 6). It is unclear whether the “system user” equates solely to “the user”, or whether there is insufficient antecedent basis for this latter limitation in the claim, since neither are properly defined in the claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9, and 11-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Osder et al. (U.S. Patent Number 5,493,606), hereinafter referred to as Osder, in view of Martino (U.S. Patent Number 5,805,676), hereinafter referred to as Martino.

11. Osder disclosed a centralized storage for audio prompt files in Column 6, Lines 33-46 (SPINDB). Transfer of prompt files from this remote centralized server to a local storage was taught by Osder, inter alia, in Column 9, Line 65 through Column 10, Line 5. The nature of caching requires cache storage(s) were logically more local than remote, hence, locally stored prompt files. User-defined element types and constructions were also expressly disclosed in, inter alia, Column 10, Lines 55-67. Naturally, end user client terminal devices were optionally telephony and/or standard computing equipment. See, Osder, inter alia, Column 1, Lines 14-33, and Column 8, Lines 37-56.

12. While Osder disclosed the invention substantially as claimed, Osder did not expressly recite user client devices operating to specify which (subset of) files to transfer from remote

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stores. While it may be argued that user(s) and network application caches specified information relating to the type of data stored, e.g., language preference, and customized element/prompt construction(s), which was derived from user input and logically grouping prompt elements together (inter alia, Column 3, Line 48 through Column 4, Line 4, Column 8, Lines 17-56), Osder did not expressly disclosed user selection of particulars effecting transfer and local storage of files.

13. Osder utilized database (15) (SPINDB) for which details of specifics regarding the specific implementation of this database were omitted. This would have motivated one skilled in the art to search the related database arts for teachings relating to implementation of a database which was used by the Osder system

14. In the art of telephone prompt database operation, Martino disclosed the distribution of data files, including subsets of the entirety, to one or more application specific databases located at differing logical localities to various network components. See, inter alia, Column 9, Lines 19-30, and Column 10, Lines 27-38. Further, Martino specifically disclosed the use of user database(s) as well as remote central database usage. See, inter alia, Column 22, Lines 16-30. The abstract also disclosed the provision for local storage of data streams (i.e., prompt elements and constituent portions) used for user interaction. In short, the system provided, among other things, the use of distributed database(s), including local storage sections, in a menu system using voice, text, and other types of data through modular construction of dynamically generated prompts on various types of computing equipment, including phones, and a number of modified embodiments of the disclose system. See, inter alia, Abstract, and Columns 23-24.

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15. It would have been obvious to one of ordinary skill in the art to modify the teachings of multi-lingual prompt management for network applications as provided by Osder with the distributed database aspects used in a network application providing prompt and menu delivery, presentation, and construction as provided by Martino in order to provide local storage for distributed storage, caching, addressing, and retrieval of menu prompt elements. See, inter alia, Osder, Column 3, Lines 55-60, and Martino, Column 10, Lines 27-29.

16. Since the combination of Osder and Martino disclosed all the limitations of the claimed invention as broadly set forth, claims 1-9, and 11-12 are rejected.

Allowable subject matter

17. Claims 10 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. Claims 10 and 13 recite the provision for user specification of language preferences, location, and subscribed-to telecommunication services as part of specified user characteristics utilized for controlling the downloading of subsets of prompt/announcement files resident at a centralized remote store (server) to a local telecommunication device store resident locally to the user (client), which is not fairly taught or suggested by the prior art of record.

Response to Arguments

19. The arguments presented by Applicant in the response to the final Office action mailed 6/2/2004, received on 10/4/2004, are not considered persuasive.

20. Applicant asserts an analogy between the user client to a "called party". This line of reasoning is unclear since the nature of a client terminal is to request something. A "called

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party” in a typical telephony environment did not request anything. The claims dictate a user, a client device, and the subsequent transfer of files based on user selection. Indeed, no discussion of how the “‘user/subscriber/client’ can be likened to the called party” (emphasis in original) as generally alleged is even present in the response. No simple correlation, relationship, or equivalence between a user client and a called party can be readily ascertained. Thus, any asserted difference between the prior art of record and the current claims based on this comparison is simply not detailed enough to distinguish over the teachings of the art of record.

21. Applicant asserts lacking of the applied art of record to disclose or suggest user selection of prompt information and subsequent transfer of user selected prompt files to the user client device. It is asserted this feature was clearly disclosed by the prior art as currently applied.

22. The breadth of the claims remains such that simple selection and transfer of user selected audio files from a central storage server meets the claimed invention set forth in the independent claims. Applicant has had two opportunities to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP § 2111. Applicant employs broad language which includes the use of words and phrases which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings which are broader than Applicant’s disclosure, the Examiner is forced to interpret the

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claim limitations as broadly as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intend broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to clearly, distinctly, and uniquely claim the invention. The current claims infer coverage breadth which is inconsistent with breadth of the disclosure and are not found distinguishable above the prior art of record.

23. Lastly, Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, Jr. can be reached at 571-272-3925. The fax phone number for the organization where this application or proceeding is assigned remains 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARC D. THOMPSON
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